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09/827,154

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Masaki Miyazaki

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EXAMINER

NGUYEN, NGA B

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,154

Applicant(s)

MIYAZAKI ET AL.

Examiner

Nga B. Nguyen

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is the answer to the communication filed on May 16, 2006, which paper has been placed of record in the file.
2. Claims 1-19 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-19 have been considered but are not persuasive.

In response to applicant's argument that Korman does not disclose an automate teller machine is managed by a predetermined managing financial institution of a plurality of financial institutions, with which the automated teller machine is used for transactions (claim 4), examiner submits that Korman discloses a Super-ATM can process traditional ATM transactions, non-traditional ATM transactions, and POS transactions (see abstract), and the Super-ATM can process a variety of transactions with a variety of service providers (column 1, lines 60-67). It is obvious that traditional ATMs allow the user to perform traditional ATM transactions (deposit, withdraw, etc.) with the user's bank. Because the Super-ATM allows the user to perform traditional ATM transactions, thus the Super-ATM must be operated by the user's bank in order to provide traditional ATM transactions to the user. Moreover, the Super-ATM also allows the user to perform variety different non-traditional ATM transactions with different service providers. Therefore, the Super-ATM of Korman, is managed by a predetermined managing financial institution (e.g., traditional ATM transactions with the

user's bank) for transactions with a plurality of financial institutions (non-traditional ATM transactions with other service providers).

In response to applicant's argument that Korman does not disclose wherein the relay center updates counters provided therein based on said transaction request message or said transaction response message, examiner submits that the host computer includes the message engine (equivalent to a counter) processes and keeps track of all of the received messages (column 10, lines 45-58).

In response to applicant's argument that Korman does not disclose a settlement amount the plurality of financial institution systems, examiner submits that Korman discloses the host computer completes the transactions by initiating a balance authorization if payment is being made using a card, carrying out the transaction event if payment was made in cash, etc. (column 11, lines 26-35).

In response to applicant's argument that Korman does not disclose identifying an associated financial institution, with which a transaction is to be conducted, based on said account identifying medium inserted into said automated teller machine, examiner submits that Korman allows the user to use various payment means, e.g. credit card, debit card, smart card, etc. at Super-ATM (column 2, lines 50-65).

In response to applicant's argument that Korman does not disclose receiving menu screen information through a network, the menu screen information being created by each of a plurality of financial institution, examiner submits that Korman discloses the user can perform non-traditional ATM transactions, e.g., purchasing tickets, at the Super-ATM, for example, an ATM user who is interested in seeing a theater event, the

user can navigate the user menus that are displayed on the Super-ATM monitor, the theater information would be downloaded to the Super-ATM and the monitor would display the various events scheduled allowing the user to purchase the desired ticket (column 7, line 55-column 8, line 12).

In conclusion, for the reason set forth above, Korman does anticipate the claimed invention, therefore, examiner decides to maintain the previous rejections (also see details below) and make this Office action FINAL.

4. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-10 and 13-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Korman et al, (hereinafter Korman), U.S. Patent No. 6,308,887.

Regarding to claim 1, Korman discloses a method of handling a financial transaction using an automated teller machine that accepts an account identifying medium for identifying an account at one of a plurality of financial institutions, said medium being provided by said one of a plurality of financial institutions, comprising the steps of:

identifying an associated financial institution, with which a transaction is to be conducted, based on said account identifying medium inserted into said automated teller machine (column 2, lines 50-65, the user can use various payment means at Super-ATM, e.g. credit card, debit card, smart card, etc.);

creating an associate transaction request message based on information of said identified associated financial institution (column 9, lines 33-35, Super-ATM prompts the user for information on the desired transaction);

transmitting said created associate transaction request message to a computer system of said associated financial institution through a relay center, without passing through a computer system of another financial institution (column 9, lines 35-38 and figure 3, Super-ATM transmits the information to the host computer 40, the host computer 40 then transmits to the appropriate remote terminal 60); and

receiving an associate transaction response message corresponding to said transaction request message from the computer system of said associated financial institution through said relay center (column 9, lines 38-42, the host computer 40 receives the data back from the remote terminal and relays back to the appropriate Super ATM).

Regarding to claim 2, Korman further discloses wherein a counter provided at said relay center for each associated financial institution is updated based on said transaction request message or said transaction response message (column 10, lines 45-58, the message engine processes and keeps track of all of the received messages).

Regarding to claim 3, Korman further discloses wherein said automated teller machine is managed by a particular financial institution, further comprising the steps of:

identifying a non-associated financial institution, with which a transaction is to be conducted, based on said account identifying medium inserted into said automated teller machine (column 2, lines 50-65, the user can use various payment means at Super-ATM, e.g. credit card, debit card, smart card, etc.);

creating a non-associate transaction request message based on information of said identified non-associated financial institution (column 9, lines 25-32 and figure 3, e.g. credit card processing network 430 is utilized to verify and process credit card transactions);

transmitting said created non-associate transaction request message to a computer system of said non-associated financial institution through said relay center (column 9, lines 35-38 and figure 3, Super-ATM transmits the information to the host

computer 40, the host computer 40 then transmits to the appropriate remote terminal 60); and

conducting a transaction with said non-associated financial institution through the computer system of said particular financial institution (column 9, lines 40-50).

Regarding to claim 4, Korman discloses a method of displaying financial transaction menu screens on a display of an automated teller machine that is managed by a predetermined managing financial institution, comprising the steps of:

accepting a medium that has identification information for identifying an account at one of a plurality of financial institutions (column 2, lines 50-65, the user can use various payment means at Super-ATM, e.g. credit card, debit card, smart card, etc.);

identifying a financial institution based on said accepted medium (column 14, lines 58-65, selecting at the transaction terminal a service offered by one of the service providers in response to the request if the identification information is confirmed); and

if said identified financial institution is not said managing financial institution, displaying a financial transaction menu screen unique to said identified financial institution on said display in place of a menu screen created by said managing financial institution (column 7, lines 55-67, non-traditional transactions).

Regarding to claim 5, Korman further discloses wherein after said financial institution is identified, a menu screen previously stored in said automated teller machine is displayed on said display as an initial transaction menu, and one or more succeeding menu screens received from a remote location are displayed on said display (column 7, lines 55-67).

Regarding to claim 6, Korman discloses a method of displaying menu screens for use in financial transactions with an associated financial institution and a non-associated financial institution on a display of an automated teller machine that is managed by a managing financial institution, comprising the steps of:

if a card for said associated financial institution is accepted, identifying said associated financial institution based on said card and displaying a menu screen unique to said identified financial institution on said display (column 4, lines 50-65, Super-ATM displays messages and user menus included transitional choices and non-traditional choices); and

if a card for said non-associated financial institution is accepted, displaying a menu screen for a non-associated financial institution created by said managing financial institution on said display (column 7, lines 55-67 and column 4, lines 60-65, the Super-ATM display the menus included non traditional choices).

Regarding to claim 7, Korman discloses a system of using an automated teller machine, comprising:

an automated teller machine for identifying a financial institution based on an account identifying medium to conduct a financial transaction with a customer (figure 3, Super-ATM 10);

a plurality of financial institution systems for conducting transactions with said automated teller machine (figure 3, remote terminal 60); and

a relay center for relaying transactions between said automated teller machine and said financial institution systems (figure 3, host computer 40);

wherein said relay center transmits a transaction request message from said automated teller machine to one of the financial institution systems identified by said automated teller machine without passing through another financial institution system, and wherein said relay center transmits a transaction response message transmitted from said identified financial institution system to said automated teller machine (column 9, lines 35-38 and figure 3, Super-ATM transmits the information to the host computer 40, the host computer 40 then transmits to the appropriate remote terminal 60; column 9, lines 38-42, the host computer 40 receives the data back from the remote terminal and relays back to the appropriate Super ATM).

Regarding to claim 8, Korman further discloses wherein said identified financial institution system updates counters provided therein based on said transaction request message or said transaction response message, and wherein said relay center updates counters provided therein based on said transaction request message or said transaction response message (column 10, lines 45-58, the message engine processes and keeps track of all of the received messages).

Regarding to claim 9, Korman further wherein said relay center defines a settlement amount after exchanging information of the counters provided in said identified financial institution systems and the counters provided in said relay center (column 11, lines 18-35).

Regarding to claim 10, Korman further discloses wherein said automated teller machine is managed by a particular financial institution, wherein a settlement with said relay center is performed by said particular financial institution or a selected financial

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institution other than said particular financial institution, and wherein if a settlement is performed by said selected financial institution, said selected financial institution performs a settlement with another financial institution (column 9, lines 40-50).

Claims 13-19 are written in means that contain similar limitations found in claims 1-10 above, therefore, are rejected by the same rationale.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Korman et al, (hereinafter Korman), U.S. Patent No. 6,308,887.

Regarding to claim 11, Korman discloses a system of using an automated teller machine, comprising:

an automated teller machine for identifying a financial institution based on an account identifying medium to conduct a financial transaction with a customer (figure 3, Super-ATM 10);

a plurality of financial institution systems for conducting transactions with said automated teller machine (figure 3, remoter terminal 60); and

a relay center for relaying transactions between said automated teller machine and said financial institution systems (figure 3, host computer 40);

wherein said automated teller machine enciphers a personal identification number inputted by said customer and transmits the enciphered personal identification number to said relay center for use in the identified financial institution, wherein said relay center transmits the enciphered personal identification number to the identified financial institution system (column 5, lines 15-30, the keypad is an encryption PIN pad, the keys are depressed at the PIN pad and are encrypted into messages; column 9, lines 35-38 and figure 3, Super-ATM transmits messages to the host computer 40, the host computer 40 then transmits to the appropriate remote terminal 60, it is inherited that the host computer transmits the encrypted PIN to the appropriate remote terminal because the encrypted PIN contained in the messages)

Korman does not disclose wherein said identified financial institution system deciphers said enciphered personal identification number. However, decrypting the encrypted PIN is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Korman to include the feature above for the purpose of decrypting the PIN at the remote terminal in order to recognize the PIN for verifying the user information before authorizing the transaction.

Regarding to claim 12, Korman does not disclose wherein said financial institution system has a private key and a public key, wherein said automated teller machine receives said public key from said financial institution system through said relay center,

and enciphers said personal identification number using a public key which is different for each financial institution, and wherein said financial institution system uses the private key for deciphering said personal identification number enciphered by said public key. However, encrypting/decrypting technique using public/private keys is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Korman to adopt the well known features above for the purpose of enhancing the security in processing financial transaction at the ATM.

Conclusion

9. Claims **1-19** are rejected.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (571) 272-6799.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

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C/o Technology Center 3600

Washington, DC 20231

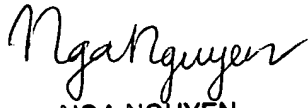
Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 501 Dulany
Street, Alexandria, VA, First Floor (Receptionist).


NGA NGUYEN
PRIMARY EXAMINER

July 20, 2006